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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/539,644	06/15/2005	Uwe Hannsmann	DE920020028US1	8626
47069 7590 04/15/2010 KONRAD RAYNES & VICTOR, LLP ATTN: IBM54 315 SOUTH BEVERLY DRIVE, SUITE 210 BEVERLY HILLS, CA 90212				
EXAMINER CHEMPAKASERIL, ANN J				
ART UNIT 2166		PAPER NUMBER		
NOTIFICATION DATE 04/15/2010		DELIVERY MODE ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

krvuspto@ipmatters.com

### Office Action Summary

**Application No.**

10/539,644

**Applicant(s)**

HANNSMANN ET AL.

**Examiner**

ANN J. CHEMPAKASERIL

**Art Unit**

2166

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 19 January 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1, 16-17, 40, 45-47, 49-50, 52-55, 57-58, 60-68 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 16-17, 40, 45-47, 49-50, 52-55, 57-58, 60-68 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Proficiency's Patent Drawing Review (PTO-544)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 2/12/2010
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

1. Claims 1, 16-17, 40, 45-47, 49-50, 52 -55, 57-58, 60-68 are pending.

***Information Disclosure Statement***

2. The information disclosure statement (IDS) submitted on 2/12/2010, has been received, entered into the record, and considered. See attached form PTO-1449

***Response to Arguments***

3. In response to Applicants argument that Aburri does not disclose decrementing the available content usage included in the file sent to the client reduced, at the client, by an amount of actual client usage of the content data at the client in response to providing access to the content data., examiner disagrees. Aburri discloses licenses 16 presently or formerly in the license store 38. Such state information is created by the DRM system 32 and stored in the state store 40 as necessary. For example, if a particular license 16 only allows a predetermined number of renderings of a piece of corresponding digital content 12, the state store 40 maintains state information on how many renderings have in fact taken place in connection with such license 16 [Col 17, lines 55-69] That is, each copy/replacement license utilizes a relatively short-term expiration date instead of the original expiration date so that long-term continued use of a copy/replacement license requires periodic contact with the license synchronization server in order to update the expiration date (hereinafter "expiry") at step 2740. [Col 58, lines 35-50]

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 16-17, 45-47, 49-50, 53 -55, 57-58, are rejected under 35 U.S.C. 103(a) as being unpatentable by US Patent Application 2003/0088516 issued to Remer et al. further in view of US Patent 7203966 issued to Aburri et al. (hereinafter Aburri)

As per claims 1, 47, and 55, Remer discloses a method for providing of content data to a client (move logic and data over networks to the end user or point- of service (POS) computer [0033]), comprising:

transmitting a selection of content data to a server (selection of licenses are requested by POS that access data, [0033]);

receiving, from the server, a file comprising license information and a locator for the content data, wherein the license information indicates a license status enabling the client to access the content data wherein the available content usage indicates an amount of content available to the client according to a scope of a license (The service agent first verifies that the digital signature of the retrieved POS license is valid (310). If so, the service agent compares the Node ID field of the current POS license with the Node ID of the existing license in the discovery database (330). If the Node IDs are

different, then this must be a new POS license that has not yet been collected to the discovery database. The service agent collects a copy of the new POS license into the Servicing component's discovery database (340). [0077]);

Remer does not appear to explicitly disclose, receiving selection of the content data; determining whether available content usage in the license status indicates that access to the content data is permitted; providing access to the content data in response to determining that the available content usage permits access; decrementing the available content usage included in the file sent to the client reduced, at the client, by an amount of actual client usage of the content data at the client in response to providing access to the content data.

receiving selection of the content data; determining whether available content usage in the license status indicates that access to the content data is permitted; providing access to the content data in response to determining that the available content usage permits access (The license includes: a decryption key (ED) that decrypts the encrypted digital content; a description of the rights (play, copy, etc.) conferred by the license and related conditions (begin date, expiration date, number of plays, etc. [Col 3, lines 5-15]);

decrementing the available content usage included in the file sent to the client reduced, at the client, by an amount of actual client usage of the content data at the client in response to providing access to the content data. (corresponding to licenses 16 presently or formerly in the license store 38. Such state information is created by the DRM system 32 and stored in the state store 40 as necessary. For example, if a

particular license 16 only allows a predetermined number of renderings of a piece of corresponding digital content 12, the state store 40 maintains state information on how many renderings have in fact taken place in connection with such license 16 [Col 17, lines 55-69] That is, each copy/replacement license utilizes a relatively short-term expiration date instead of the original expiration date so that long-term continued use of a copy/replacement license requires periodic contact with the license synchronization server in order to update the expiration date (hereinafter "expiry") at step 2740. [Col 58, lines 35-50])

Remer and Aburri are analogous art because they are from the same field of endeavor of providing data to clients

It would have been obvious to modify the invention Remer to include the feature of Aburri. Modification allows the user to render the digital content according to the rights conferred by the license and specified in the license terms. [Col 3, lines 35-50])

As per claim 16, 49, and 57, Remer discloses the generated file comprises an XML file having a defined DTD format (The exchange of licenses may be accomplished in a number of ways. In one example implementation of the method, the exchange is accomplished by formatting an exchange license file that is in well-formed, non-validated XML described by the following DTD [0087]).

As per claim 17, 50, and 58, Aburri discloses sending, by the client, to the server a request to renew the license and make payment for the renewal in response to the client determining that the available content usage in the license status indicates that the license has expired (A purpose of such contact is to synchronize the server's license

information with the user's device's license information. For example, when user next connects to synchronization server 1402 from a computing device, e.g. 1302a, any new licenses now contained in the license store 1524 on license synchronization server 1402 will be downloaded to device 1302a and any licenses contained in license store 1510a on device 1302a not in license synchronization server 1402 license store 1524 will be uploaded to server 1402. License synchronization server 1402 may send device 1302a copy/replacement license for any licenses that device 1302a has newly uploaded to the license synchronization server. Copy/replacement licenses are stored in license store 1510a on computing device 1302a [Col 62, lines 40-55])

Remer and Aburri are analogous art because they are from the same field of endeavor of providing data to clients

It would have been obvious to modify the invention Remer to include the feature of Aburri. Modification allows the user to render the digital content according to the rights conferred by the license and specified in the license terms... [Col 3, lines 35-50])

As per claim 39, 51, and 59, Aburri discloses the usage of the content data at the client after the license status is expired at client when there is no more available content usage. (copy/replacement license may also expire, however, if a user does not connect and synchronize with the license synchronization server from a device before the expiry date of the copy/replacement license. [Col 63-Col 64])

Remer and Aburri are analogous art because they are from the same field of endeavor of providing data to clients

It would have been obvious to modify the invention Remer to include the feature of Aburri. Modification allows the user to render the digital content according to the rights conferred by the license and specified in the license terms. [Col 3, lines 35-50])

As per claim 45, 53, and 61, Aburri discloses the available content usage indicates a fixed number of allowed play, wherein the license status is expired after the content is rendered the fixed number of allowed playbacks (The license includes: a decryption key (ED) that decrypts the encrypted digital content; a description of the rights (play, copy, etc.) conferred by the license and related conditions (begin date, expiration date, number of plays, etc. [Col 3, lines 5-15])

Remer and Aburri are analogous art because they are from the same field of endeavor of providing data to clients

It would have been obvious to modify the invention Remer to include the feature of Aburri. Modification allows the user to render the digital content according to the rights conferred by the license and specified in the license terms. [Col 3, lines 35-50])

As per claim 46, 54, and 62, Aburri discloses the available content usage indicates duration of the content playback (A copy/replacement license may expire because the end of the time period for which an original license pertains has been reached [Col 63, lines 35-40]

Remer and Aburri are analogous art because they are from the same field of endeavor of providing data to clients



It would have been obvious to modify the invention Remer to include the feature of Aburri. Modification allows the user to render the digital content according to the rights conferred by the license and specified in the license terms. [Col 3, lines 35-50])

Claims 40, 52, 60, 63-68 are rejected under 35 U.S.C. 103(a) as being unpatentable by US Patent Application 2003/0088516 issued to Remer et al. further in view of US Patent 7203966 issued to Aburri et al. (hereinafter Aburri) and further in view of Japanese Application 10215242 issued to Kazuo et al. (hereinafter Kazuo)

As per claim 40, 52, and 60, Kazuo discloses permitting access to the content data in response to determining that the available content usage in the license status indicates that the license has expired; tracking content usage in response to determining that the available content usage indicates that the license has expired and permitting access to the content data after the license has expired; synchronizing with the server to transmit the tracked amount of usage of the content data at the client after the license status is expired at client (delivering a usage history to a center 30 at a suitable time [0054]);

Kazuo discloses providing payment for the amount of usage of the content data after the license status is expired(A fee calculated based on a collected history is charged directly from each user's account and distributed to content provider according to utilization quantity of each contents [0054])

Remer in view of Aburri and Kazuo are analogous art because they are from the same field of endeavor of providing data to clients

It would have been obvious to modify the invention Remer in view of Aburri to include the feature of Kazuo. Modification allows the user to pay for contents based on how much it is utilized. [0054])

As per claims 63, 65 and 67, Kazuo discloses access to the content data in response to determining that the available content usage in the license status indicates that the license has expired is permitted in response to the client not being able to connect to the server, and wherein the synchronization occurs when the client is able to reconnect to the server (delivering a usage history to a center 30 at a suitable time [0054])

Remer in view of Aburri and Kazuo are analogous art because they are from the same field of endeavor of providing data to clients

It would have been obvious to modify the invention Remer in view of Aburri to include the feature of Kazuo. Modification allows the user to pay for contents based on how much it is utilized. [0054])

As per claims 64, 66 and 68, Kazuo discloses the operations further comprise: determining whether the file permits the user to continue to use the content data after the license has expired, wherein the operations of permitting access to the content data in response to determining that the license has expired and tracking content usage is performed in response to determining that the file permits the user to continue to use the content data after the license has expired (Information about utilization conditions, such as utilization charge, a payment method, the expiration date, is given to an access ticket in addition to information about access control [0054]).

Remer in view of Aburri and Kazuo are analogous art because they are from the same field of endeavor of providing data to clients

It would have been obvious to modify the invention Remer in view of Aburri to include the feature of Kazuo. Modification allows the user to pay for contents based on how much it is utilized. [0054])

### ***Conclusion***

5. Applicant's submission of an information disclosure statement under 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p) on 2/12/2010 prompted the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 609.04(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

**Contact Information**

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ann J. Chempakaseril whose telephone number is 571-272-9767. The examiner can normally be reached on Monday through Thursday, 9-4.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hosain Alam can be reached on (571) 272-3978. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Ann J Chempakaseril/  
Examiner, Art Unit 2166  
April 10, 2010

/Hosain T Alam/

Supervisory Patent Examiner, Art Unit 2166